

REMARKS

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lee* (U.S. Patent 6,516,418) in view of *Su et al* (U.S. 5,327,016).

This rejection is not applicable to the claims as amended.

Claims 1, 11 and 21 each include: interrupting current to an external module of the IHS if, when the IHS is drawing power from a DC power source, the current to the external module exceeds a first current limit of a first value associated with a first voltage; and interrupting current to the external module if, when the IHS is drawing power from an AC power source, the current to the external module exceeds a second current limit of a second value different from the first value and associated with a second voltage different from the first voltage.

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach interrupting current to an external module of the IHS if, when the IHS is drawing power from a DC power source, the current to the external module exceeds a first current limit of a first value associated with a first voltage; and interrupting current to the external module if, when the IHS is drawing

power from an AC power source, the current to the external module exceeds a second current limit of a second value different from the first value and associated with a second voltage different from the first voltage.

Therefore, it is impossible to render the subject matter of claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination because neither teaches or suggests interrupting current to an external module of the IHS if, when the IHS is drawing power from a DC power source, the current to the external module exceeds a first current limit of a first value associated with a first voltage; and interrupting current to the external module if, when the IHS is drawing power from an AC power source, the current to the external module exceeds a second current limit of a second value different from the first value and associated with a second voltage different from the first voltage.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

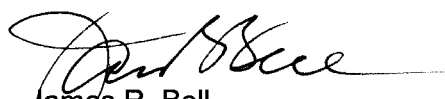
The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

In view of the above, the allowance of claims 1-21 is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


James R. Bell
Registration No. 26,528

Dated: 5-9-06
HAYNES AND BOONE, LLP
901 Main Street, Suite 3100
Dallas, Texas 75202-3789
Telephone: 512/867-8407
Facsimile: 214/200-0853
ipdocketing@haynesboone.com